

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor	:	Robert Bruce Spertell
App. No	:	09/637,923
Filed	:	August 14, 2000
For	:	METHOD AND APPARATUS FOR TREATING SUBCUTANEOUS HISTOLOGICAL FEATURES
Examiner	:	Fadi H. Dabour
Art Unit	:	3742

STATEMENT OF MARK DEEM SUPPORTING UNINTENTIONAL ABANDONMENT
UNDER 37 C.F.R. § 1.137(b)

I, Mark Deem, do hereby state as follows:

1. I am a citizen of the United States, and am the Chief Executive Officer of Miramar Labs, Inc., an early stage private medical device company and the current assignee of the present application by virtue of the chain of title discussed below. I received a B.S. degree in biomedical engineering from Boston University and have over 20 years of experience in the medical device field. I am a co-inventor on over 20 issued U.S. patents and more than 50 U.S. pending patent applications. My mailing address is 199 Jefferson Drive, Menlo Park, CA 94025.

2. I have reviewed the Decision on Petition mailed May 30, 2008 dismissing the petition to revive the above-identified application under 37 C.F.R. § 1.137(b).

3. While researching intellectual property of potential interest to Miramar Labs, Inc., circa August 2007, I came across U.S. Patent Nos. 6,104,959 and 6,334,074, to Robert B. Spertell which were listed on the face of the patent as assigned to Microwave Medical and MW Medical, Inc., respectively. I determined that the patents had expired for failure of payment of maintenance fees.

4. After performing further due diligence into the ownership of the aforementioned U.S. patents, I discovered, in the continuity data listed on PAIR, the existence of the above-identified application, which was a divisional of the '959 patent. The parent application of the

Docket No. : **MWMED.001DV1**
Appl. No. : **09/637,923**

‘923 Application was assigned from Spertell to Microwave Medical Corporation. The assignment document expressly assigned all divisional applications (i.e., the present application) to Microwave Medical as well, and was recorded in the United States Patent and Trademark Office on July 31, 1997 at Reel 008662 and Frame 0965 (See Exhibit 9).

5. I further discovered that both MW Medical, Inc. and Microwave Medical Corporation filed for Chapter 11 bankruptcy in the District Court of Arizona (No. 02-01090-ECF-RTB and 02-01298-ECF-GBN). At least in part because Microwave Medical Corporation was a wholly owned subsidiary of MW Medical, Inc., the bankruptcy cases were consolidated. (See Exhibit 11). Thus, the assets and claims of the two entities were likewise consolidated. The successor company MW Medical, Inc. emerged from bankruptcy on November 19, 2002. None of the bankruptcy documents nor PTO assignment records indicated that any of the intellectual property had been assigned to a third party by the close of bankruptcy, thus any assets of Microwave Medical would be owned by MW Medical, Inc. following bankruptcy.

6. I instructed Miramar Labs’s intellectual property counsel, Sabing Lee and Bryan Wahl of Knobbe Martens Olson & Bear LLP, to further research the status of the present application. After obtaining the file history, counsel informed me that the above-identified application had gone abandoned on September 6, 2002 for failure to respond to an Office Action mailed June 5, 2002.

7. Upon review of public Security and Exchange Commission databases, I discovered an assignment agreement that specified all intellectual property on the books of MW Medical, Inc. as of March 15, 2003 was assigned to Jan Wallace (See Exhibit 13). Thus, the present application, the ‘959 patent and the ‘074 patent were assigned to Jan Wallace.

8. Having determined that Wallace was the assignee of the present application, as well as the related ‘959 and ‘074 patents (which were expired due to non-payment of maintenance fees) I approached her, unsolicited, circa November 2007 regarding the possibility of acquiring her assets formerly owned by MW Medical, including the rights to the present application. After several discussions with Wallace, I discovered that she was completely unaware that the above-identified application had gone abandoned, and that the ‘959 and ‘074 patents had expired for non-payment of maintenance fees. After obtaining Wallace’s consent, I also contacted attorneys who I found were involved with the prosecution of the present application, namely Raymond A. Bogucki, a solo practitioner, and Douglas Hanscom of Jones

Docket No. : **MWMED.001DV1**
Appl. No. : **09/637,923**

Tullar and Cooper, P.C. to learn more regarding the circumstances of the expiration of the two patents and abandonment of the above-identified application. I found that they had been unable to reach their client and as such did not know their client's intention regarding the above-identified application, nor that the rights to the above-identified application had been assigned to Jan Wallace in 2003.

9. After an extended period of negotiations lasting from November 2007 until January 2008, Wallace assigned her rights to the present application, among other assets, to Miramar Labs by virtue of an assignment agreement dated January 24, 2008 (see Exhibit 14).

10. Upon Wallace's assignment of the '959 and '074 patents as well as the present application to Miramar Labs on January 24, 2008, I became aware that Wallace had already instructed her patent agents to file petitions to accept delayed maintenance fee payments for the '959 and '074 patents under an unintentional standard. I understand that Wallace had not yet filed any petition to revive the present application because she had difficulty obtaining the file history and obtaining additional facts regarding its abandonment.

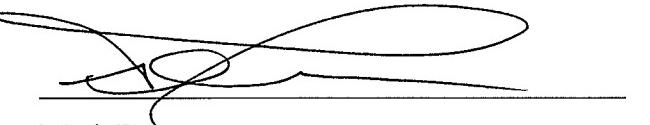
11. Immediately following Miramar Labs' becoming the assignee of the present application on January 24, 2008, I instructed Miramar's intellectual property counsel Lee and Wahl at Knobbe Martens to prepare a petition to revive the present application, and contact potentially relevant parties including Bogucki, Hanscom, Wallace, and Grace Sim (the former Chief Financial Officer at MW Medical, Inc., who I understand was responsible for handling the intellectual property including the present application at the time of the present application's abandonment). Miramar's counsel concurred, after reviewing the file history and associated documents and interviewing the aforementioned individuals, that the present application was abandoned unintentionally, and diligently prepared the petition to revive an application unintentionally abandoned under 37 C.F.R § 1.137(b), along with the requisite amendment and response to the Office Action mailed June 5, 2002. The petition to revive electronically filed with the USPTO on March 7, 2008.

12. I believe that the entire delay from the time that Miramar Labs became the assignee of the above-captioned application on January 24, 2008 to the filing of the revival petition on March 7, 2008 was unintentional.

Docket No. : **MWMED.001DV1**
Appl. No. : **09/637,923**

13. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therefrom.

Date: 9/26/08



Mark Deem
Chief Executive Officer
for Assignee Miramar Labs, Inc.

5703969
072408